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| 09/519,889 | 03/06/00 | REDMAN | R R597.12-003 |

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EXAMINER

FALIK, A

ART UNIT

PAPER NUMBER

3765

DATE MAILED:

06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/519,889

Applicant(s)

Redman et al

Examiner

Andy Falik

Art Unit

3765



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 3, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 3765

DETAILED ACTION

Drawings

The drawings are again objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the decorative indicia recited in claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Pursuant to Applicants' remarks on page 7 in their 5/11/01 they are respectfully requested to show where the sleeve markings are located in the Figs. 1,2,5, and 6. The only markings the Examiner sees looks like wrinkles.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As stated in the last Office action claims 1,2,5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot (2,904,792) in view of Bourdeau et al (4,868,927) where it would have been obvious to the person of ordinary skill in the glove making art at the time of the invention to replace the series of aligned apertures and a cord in the '792 glove with the '927

Art Unit: 3765

zipper to provide for a more secure closing of the '792 glove on the wearer's arm. It is noted that Fig. 1 in '792 shows a plurality of fingers passing through a single digit opening.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over 2,904,792 in view of 4,868,927 as applied to claim 1 above, and further in view of De Leo (5,173,966) where it would have been further obvious to the aforementioned glove maker to include the indicia 42 appearing in Fig. 1 in '966 on the thumb side of the glove 1 in Fig. 1 in '792 for the advantage of enabling the wearer to initially pick up the '792 glove and easily apply it onto his hand with the thumb side in a proper relative sense.

Applicants' remarks to these rejections appearing in the last 2 paragraphs on page 3 and the first 3 paragraphs on page 4 in their response have been considered but aren't deemed persuasive since they are arguing an unclaimed limitation that if included in independent claim would obviate the rejection, namely: "This element defines the sleeve as extending up to but leaving the knuckles of the digits of the hand exposed."

Claims 1&3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews (5,402,536) in view of 4,868,927 (supra.) where it would have been obvious to the person of ordinary skill in the glove making art to include the '927 zipper on a side of the '536 glove for the aforementioned ease of donning reason. Fig. 3 in '536 shows the claim 3 sleeve length arrangement.

As above, Applicants in their remarks to the this rejection are arguing but not claiming the aforementioned "exposed knuckle" limitation. The joints shown at 82 in Fig. 6 in the '536

Art Unit: 3765

reference anticipate the recited first set of joints. Additionally, claim 1 includes no language which precludes the individual finger openings of '536, since like the claim they also allow all of the wears fingers to extend therethrough. It is noted however that if --single-- was inserted before "discrete" on the fourth line in claim 1 this rejection would be obviated.

Recapture of Surrendered Subject Matter

As stated in the previous Office action claims 1-6 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The cancellation of lines 11-15 and 17-19 in patent claim 1(amended) constitutes the broadening aspect since these lines were added to the original patent claim 1 to define over the

Art Unit: 3765

'792 and 419' references supra. The criticality of the subject matter in said canceled lines is argued on pages 2 and 5 in the 7/23/98 Amendment associated with parent application 08/968,977.

The Examiner begs to differ with Applicants comments to recapture problem on page 6 in their response arguing that the claimed subject matter defining (1) the forearm protector extending past the knuckles and up to the first set phalanges leaving the joints of the phalanges exposed and (2) the thumb opening of said forearm protector extending up to the joint of the phalanges leaving the joint exposed was not supported by their specification and hence was not available to be surrendered. It is the Examiner's position that since this subject matter was claimed and shown in the drawings in the original application it was part of the original application it thus did exist for the purpose of being surrendered. The specificity of applicants' arguments to these limitations on said pages 2 and 5 and how their inclusion into original claim 1 distinguishes it from the '792 and '419 references supports this position.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3765

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The amendatory response to this Office action must comply with the new procedures specified in the revised 37 CFR 1.121.

Any inquiry to the merits of this office action or to any specific features of this communication or earlier communications from the examiner should be directed to Andy Falik whose telephone number is (703) 308-1283. The examiner can normally be reached on Monday-Thursday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvert can be reached on (703) 305-1025. The fax phone number for this Group is (703) 305-3588.

Any inquiry of a general nature such as a missing reference or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861. Any inquiry relating to the drawings should be directed to the Drafting Branch whose telephone number is (703) 305-8404.


**ANDY FALIK
PRIMARY EXAMINER
GROUP 3765**

AMF
June 14, 2001